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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,490	10/31/2001	Stanley J. Kopecky	112703-206	3231
29156	7590	05/27/2005	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,490

Applicant(s)

KOPECKY, STANLEY J.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action acknowledges the applicant's Amendment submitted 3 March 2005. Claims 1-22 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ranney (US 2,380,367) in view of Hachenski (US 6,138,905), Howes (US 5,896,686), and Focke et al (US 5,375,704).

Regarding claims 1 and 9, Ranney discloses a gum package (Figure 1) having a body (16) with a removable end wall (16'). Body (16) stores gum after the end wall is removed (see Figure 2). The removable end wall (16') has an inner surface, the entirety of which is only visible when the end is removed. End wall (16') is at least partially and permanently removed from the body upon separation of tear strip (21). Ranney is deformable and meets all limitations claimed by the applicant except for giveaway information being unobstructed by the folds of the end wall and visible by viewing the inner surface.

Hachenski discloses a container with printed matter on the inner surface of its lid. Hachenski teaches the provision of a promotion (see Col. 6, lines 20-23). Howes teaches the equivalence of a promotion and giveaway information. Hachenski discloses

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providing the information on the inside of the closure and only visible when the package is opened (see for example, Col. 2, lines 39-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the gum package of Ranney with giveaway information on the inner surface of the closure as taught by Hachenski and Howes in order to promote the sale of the product.

Focke et al discloses a package (12) with giveaway information provided on a removable insert (28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Ranney-Hachenski-Howes with a removable insert as taught by Focke et al in order to limit the production requirements of the consumer to claim their prize (i.e., it would only be necessary for the consumer to provide the insert to claim the prize).

The package of Ranney-Hachenski-Howes-Focke discloses the claimed invention.

As to claim 2, the gum package of Ranney is rectangular in shape.

As to claim 3, the gum package of Ranney discloses tab and ribbon (21, as shown, Figure 1).

As to claim 4, the gum package of Ranney is constructed in part from a flexible foil.

As to claim 5, Howes discloses giveaway information adapted to inform the consumer whether or not they have won a prize.

As to claim 6, Howes discloses giveaway information concerning a contest.

As to claim 7, Hachenski discloses information printed on the inner surface.

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As to claim 8, Focke et al does not expressly disclose stamping information on the inner surface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the giveaway information on the inner surface of the end wall of the gum package of Ranney-Hachenski-Howes-Focke by stamping since the examiner takes Official Notice of the equivalence of stamping and printing for their use in the information providing art and the selection of any of these known equivalents to provide giveaway information would be within the level of ordinary skill in the art.

As to claim 10, the gum package of Ranney houses a plurality of sticks of chewing gum.

Regarding claims 11 and 17, Ranney discloses a package (Figure 1) having a flexible body (16) with inner surfaces defining an interior for housing products and a removable end wall (16'). Body (16) stores the confectionery product after the end wall is removed (see Figure 2). The removable end wall (16') has an inner surface, the entirety of which is only visible when the end is removed. The removable end wall (16') is at least partially and permanently removable by grasping and pulling member (21). Ranney is deformable and meets all limitations claimed by the applicant except for giveaway information being unobstructed by the folds of the end wall and visible by viewing the inner surface.

Hachenski discloses a container with printed matter on the inner surface of its lid. Hachenski teaches the provision of a promotion (see Col. 6, lines 20-23). Howes teaches the equivalence of a promotion and giveaway information. Hachenski discloses providing the information on the inside of the closure and only visible when the package

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is opened (see for example, Col. 2, lines 39-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the gum package of Ranney with giveaway information on the inner surface of the closure as taught by Hachenski in order to promote the sale of the product.

Focke et al discloses a package (12) with giveaway information provided on a removable insert (28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Ranney-Hachenski-Howes with a removable insert as taught by Focke et al in order to limit the production requirements of the consumer to claim their prize (i.e., it would only be necessary for the consumer to provide the insert to claim the prize).

The package of Ranney-Hachenski-Howes-Focke discloses the claimed invention.

As to claim 12, member (21) of Ranney is a tab.

As to claim 13, Ranney discloses grasping a tab and tearing a portion of the body to remove the end wall.

As to claim 14, Hachenski discloses information printed on the inner surface.

As to claim 15, the package of Ranney is constructed in part from a flexible foil.

As to claim 16, the package of Ranney is rectangular in shape.

Regarding claim 18, the gum package of Ranney-Hachenski-Howes-Focke as applied above discloses the claimed method by presentation.

As to claim 19, the package of Ranney-Hachenski-Howes-Focke provides a tab for tearing the package to remove the end wall.

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As to claim 20, the package of Ranney-Hachenski-Howes-Focke discloses providing printing on the inner surface.

As to claim 21, the package of Ranney-Hachenski-Howes-Focke discloses providing printing on the inner surface. Ranney-Hachenski-Howes-Focke does not expressly disclose stamping information on the inner surface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the giveaway information on the inner surface of the end wall of the gum package of Ranney-Hachenski-Howes-Focke by stamping since the examiner takes Official Notice of the equivalence of stamping and printing for their use in the information providing art and the selection of any of these known equivalents to provide giveaway information would be within the level of ordinary skill in the art.

As to claim 22, the package of Ranney-Hachenski-Howes-Focke is rectangular in shape.

Response to Arguments

4. Applicant's arguments filed 3 March 2005 have been fully considered but they are not persuasive.

5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation can be found in the prior art of record (see for example, Hachenski Col. 6, lines 20-23).

6. In response to applicant's argument that Hachenski, Howes, and Focke teach away from the claimed invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

7. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
17 May 2005



Mickey Yu
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Group 3700